

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GLENN W. PALMWAY-RILEY



Appeal No. 2005-1246
Application No. 09/776,147

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's non-final rejection (mailed October 21, 2003) of claims 23 and 24, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a fishing hook. A copy of dependent claim 24 is set forth in the appendix to the appellant's brief. Claim 23 reads as follows:

A fishing hook comprising a body composed of a metal which is exposed for contact with water, a winding of metal, said winding having a central opening with said body being within the central opening such that the winding extends around the body in multiple turns to form a coil, the metal of said winding being exposed for contact with water, and a nonconductive insulating layer between the winding and the body to insulate the winding from direct contact with the body, wherein the winding and the body are of dissimilar metals such that immersion of the hook in water results in the generation of a fish-attracting electromagnetic field as a result of electrolytic action between the two metals.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Goddard et al. (Goddard)	2,384,993	Sept. 18, 1945
Massie	4,970,808	Nov. 20, 1990

Claims 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goddard in view of Massie.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the non-final action (mailed October 21, 2003) and the answer (mailed June 17, 2004) for the

examiner's complete reasoning in support of the rejection, and to the brief (filed January 12, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we will sustain the rejection of claims 23 and 24 for the reasons which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than

expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein).

With this as background, we first analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Goddard's invention relates to improvements in artificial bait and has for its object the provision of a fish lure especially adapted for casting and devised to resemble a fly or similar winged insect. In carrying out the invention, Goddard employs a common fishhook having a shank 5, a bill 6 and an eye 7. The portion of the shank adjoining the eye is supplied with a tightly wound lapping of fibrous material, such as a thread, suitable to provide an enlargement constituting a head 8 of a fly. This lapping serves to secure a pair of eyelets 9 to the shank as best shown in Figure 3. The eyelets are use to connect wings 14. The shank is covered with a body-forming material comprising a lapping of a filamentous substance 10 sufficient to cause the completed body to float. The fibrous material may include a tuft or strands disposed

loosely toward the bill, as indicated at 11. The material 10 which is lapped or massed about the shank is colored and secured in place by a lapping of a fine metal strip 12 having spaced coils and being of a different color to that of the body forming mass 10. From the end of the body there projects a colored tail feather 13, which is secured to the shank by the strip 12.

Massie's invention is directed to an electro-acoustical fishing lure. Massie teaches that fish sense, and are attracted to, sources of electric fields and sonic fields in their water habitat. One object of Massie's invention was to utilize the electrode potential of metals used in a fishing lure to radiate electric waves in the water habitat of the fish and to simultaneously produce acoustical waves in the water. Figures 1 and 2 show an electro-acoustical fishing lure 1 having fluttering electro-acoustical fishing lure electrodes 6 and 7 configured to produce a fluttering movement when suspended parallel to a fixed electrode 5. The fish-hook assembly 2 and 3 is shown attached to one end of the fixed electrode by ring 4. The fluttering electrodes are attached to the fixed electrode by insulator fitting 9 by rings 8, and the electrodes are attached to the insulator by rivets 10. Massie teaches the fluttering electrodes can be made from copper and the fixed electrode can be made from zinc.

In the answer, the examiner stated (p. 4) that Goddard implies the use of dissimilar metals in that the metal 12 is described as a fine metal (e.g., aluminum or silver) and the fishhook is inherently a metal (e.g., carbon steel or stainless steel). Then, the examiner explained why Goddard's body forming mass 10 constitutes a nonconductive insulating layer.

The appellant argues that absent the use of hindsight knowledge derived from the appellant's own disclosure¹ the applied prior art does not suggest the claimed subject matter. We do not agree.

In our view, the teachings of Goddard would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have: (1) made the fishhook of Goddard from either carbon steel or stainless steel since making fishhooks from these materials was well known in the art; (2) made the strip 12 of Goddard from aluminum, a well known fine metal²; and (3) made the body forming mass 10 of Goddard from a nonconductive insulating material. This modified bait of Goddard would inherently result in the generation of a fish-attracting electromagnetic field as a

¹ The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

² Neither carbon steel or stainless steel is a fine metal.

result of electrolytic action between the two dissimilar metals when the bait was immersed in water. As such, we find the claimed subject matter to be suggested by the teachings of Goddard. Accordingly, the decision of the examiner to reject claims 23 and 24 under 35 U.S.C. § 103 is affirmed.

For the reasons set forth above, we find the appellant's argument the claims 23 and 24 are not suggested by the teachings of the applied prior art to be unpersuasive.³

CONCLUSION


To summarize, the decision of the examiner to reject claims 23 and 24 under 35 U.S.C. § 103 is affirmed.


³ In addition, we refer the appellant to the examiner's response to that argument set forth on pages 4-5 of the answer.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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G.W. PALMWAY-RILEY
c/o L. CROUT
613 CALIOPE WAY
MT AIRY, MD 21771

JVN/jg